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| In re Application of: | : | |
| DAVIDSON, Beverly, L., et al. | : | DECISION ON RENEWED |
| U.S. Application No.: 10/522,954 | : | PETITION |
| Int'l Application No: PCT/US2003/016887 | : | |
| Int'l Filing Date: 26 May 2003 | : | |
| Priority Date: 05 August 2002 | : | |
| Atty Docket No.: 17023.045US2 | : | |
| For: ALLELE-SPECIFIC siRNA-MEDIATED : | : | |
| GENE SILENCING | : | |

This decision is issued in response to the correspondence filed by applicants on 29 January 2008, treated herein as a renewed petition for revival under 37 CFR 1.137(b). No petition fee is required.

BACKGROUND

The background for the present application was set forth in the decision mailed herein on 12 September 2007, which dismissed applicants' petition for revival under 37 CFR 1.137(b) for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had failed to submit the "required reply" in the form of an oath or declaration in compliance with 37 CFR 1.497. The decision also held in abeyance applicants' petition under 37 CFR 1.48(b), noting that such a petition could not be considered until applicants had successfully satisfied the requirements of 35 U.S.C. 371(c) by submitting an acceptable oath or declaration executed by all the inventor's of record in the international application.

On 29 January 2008, applicants filed the correspondence considered herein as a renewed petition, with required extension fee.

DISCUSSION

As indicated in the previous decision, the "required reply" necessary to satisfy the final element of a grantable petition under 37 CFR 1.137(b) is an oath or declaration in compliance with 37 CFR 1.497 executed by the five inventors of record in the international application.

The present submission includes a declaration document that names and is executed by the five inventors of record. However, the declaration is not acceptable as filed. Specifically, the declaration appears to be an unacceptable compilation of multiple documents. See MPEP

Section 201.03(II)(B): "While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration." The compilation here is evident from the fact that the six-page declaration document submitted contains three different copies of "Supplemental Sheet 1 of 2," each signed by a different inventor. Applicants must provide copies of the complete four-page declaration executed by each of the inventors (each such declaration containing all required information, including the names of all five inventors of record).

It is also noted that the declaration is defective with respect to inventor Henry PAULSON because this inventor's signature block includes hand-written alterations that were not initialed and dated (See MPEP §605.04(a) and 37 CFR 1.52(c)). Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or non-dated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). Therefore, a newly executed declaration form Henry PAULSON (containing all required information, including the names of all five inventors of record) is required.

Based on the above, applicants have failed to submit an acceptable declaration in compliance with 37 CFR 1.497. Accordingly, the final element of a grantable petition under 37 CFR 1.137(b) remains unsatisfied.

CONCLUSION

The renewed petition for revival is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition for revival is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should be entitled "Second Renewed Petition Under 37 CFR 1.137(b)" and include the materials required to satisfy the remaining element of a grantable petition, as discussed above and in the MPEP. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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